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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,938	11/03/2003	Daniel Boss	6666.110	5060

7590 02/27/2006

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EXAMINER
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CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/698,938

Applicant(s)

BOSS, DANIEL

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4, 11-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/21/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I and Species (a)(1) in the reply filed on 1/6/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 4, 11-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/6/2006.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 1-3, 5-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-63 of copending Application No. 10/698,937 (US 2005/0094311). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending Application claims an article with a damping structure comprising the recited viscoelastic layer and constraining layer, wherein the constraining layer has a greater stiffness and modulus of dynamic shearing elasticity.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

LANDIN ET AL (US 5,725,931) or SPERLING ET AL (US 3,833,404);

in view of SAITOH ET AL (US 5,695,867).

LANDIN ET AL and SPERLING ET AL both disclose viscoelastic damper structures comprising a viscoelastic layer contacting constraining layer, wherein the constraining layer comprises a polyester resin with optional fillers, the viscoelastic layer comprises an acrylic-

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based elastomer, and wherein the constraining layer is stiffer than the viscoelastic layer.

(LANDIN ET AL, line 60-68, col. 1; line 25, col. 5 to line 30, col. 6; line 7-44, col. 8)

(SPERLING ET AL, line 65-68, col. 2; line 40, col. 3 to line 5, col. 4). However, the references do not explicitly disclose the relative modulus of dynamic shearing elasticity of the two layers.

SAITOH ET AL discloses that it is well known in the art to use constraining layer materials having a typical modulus of dynamic shearing elasticity of  $10^{10}$  -  $10^{12}$  dyne/cm<sup>2</sup> in combination with viscoelastic layer materials having typical modulus of dynamic shearing elasticity of  $10^6$  -  $10^{10}$  dyne/cm<sup>2</sup> in constrained vibration dampening components in order to obtain durable vibration reduction components.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use stiffer and high modulus materials in the constraining layers of LANDIN ET AL and SPERLING ET AL, and adjust the relative difference between stiffness and modulus of dynamic shearing elasticity between the viscoelastic layer and constraining layer materials (claims 8-9) of LANDIN ET AL and SPERLING ET AL in order to obtain the optimum combination of dampening characteristics, durability and structural stability for specific applications. One of ordinary skill in the art would have utilized known reinforcing fillers (claims 6-7) in the constraining layer in order to tailor its mechanical and other physical properties for a given application.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

LANDIN ET AL (US 5,725,931) or SPERLING ET AL (US 3,833,404);

in view of SAITOH ET AL (US 5,695,867);

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as applied to claim 1 above;

and further in view of SHAFFER ET AL (US 5,855,353).

SHAFFER ET AL discloses that it is well known in art to incorporate fillers (e.g., glass fiber, carbon fiber, etc.) in constraining layers composed of polyester resin in order to improve its mechanical properties. (line 54, col. 3 to line 5, col. 4)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize known reinforcing fillers in the constraining layers of LANDIN ET AL and SPERLING ET AL in order to tailor its mechanical and other physical properties for a given application.

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*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 19, 2005



Vivian Chen  
Primary Examiner  
Art Unit 1773